

15. (Original) A jewelry case according to claim 13, wherein said means for securing said panel in a compact roll-folded configuration comprises elongate, flexible members for securing said panel in said compact roll-folded configuration by tying.

16. (Original) A jewelry case according to claim 12, wherein said main body compartment is reinforced with rigid internally disposed panel members.

17. (Original) A jewelry case according to claim 12, wherein said first panel further includes at least one closable pocket on each opposing side thereof.

REMARKS

The Office Action dated January 21, 2005 has been carefully considered. Responsive thereto, Applicant has amended the claims as indicated above, and requests that the Examiner consider the following remarks.

The drawings were objected to under 37 C.F.R. 1.83(a) for failing to show the plurality of panels foldable within the main body compartment. Claims 1 – 17 were rejected under 35 U.S.C. 112, second paragraph, for informalities. Claims 1, 2, and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by LeSage (4,324,446). Claims 1, 2 and 7 were rejected under 35 U.S.C. 102(b) as being

anticipated by Mech (5,511,873). Claims 1 – 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over LeSage or Mech in view of Roegner (5,890,587). Finally, the Examiner states that claims 8 – 17 would be allowable if amended to overcome the rejections under 35 U.S.C. 112, second paragraph.

Claims 1, 5, 8, 9, 10, and 12 have been amended. Claim 2 has been cancelled. Claims 1 and 3 - 17 remain pending. No new matter has been added. Reconsideration is respectfully requested.

The claims have been amended to a scope that is considered to be allowable in view of the issues raised by the Examiner in the Office Action. No new matter has been added. Reconsideration is respectfully requested.

OBJECTION TO DRAWINGS

The drawings were objected to under 37 C.F.R. 1.83(a) for failing to show the plurality of panels foldable within the main body compartment as recited in Claim 1. Responsive thereto Applicant has amended claim 1 to traverse the rejection. As amended, claim 1 specifies a plurality of pivotally connected panels with a cover panel including means for attachment in covering relation with the plurality of panels and the compartment. Applicant believes that the amended claim language more clearly recites the cover panel which covers the compartment and other folded panels. Applicant believes that the amendment addresses the issue raised by the Examiner.

In addition, Applicant has amended FIGS. 4 and 5 to show the panels folded over the main body and also unfolded in phantom. Properly marked

Replacement Sheets are submitted herewith. No new matter has been added. Applicant draws the Examiner's attention to: FIG. 6 wherein the main body compartment is disposed in the center with the foldable panels extending from the peripheral sides of the compartment; FIG. 5 wherein panel 46 is folded into the main body compartment (and shown unfolded/open in phantom); FIG. 4 wherein panels 42, 44, and 46 are folded into the main body compartment (and also shown unfolded/open in phantom); and FIGS. 1 – 3 wherein panel 40 is folded in covering relation with the main body compartment and the folded panels 42, 44, and 46.

Claim Rejections Under 35 U.S.C. §112

Applicant has amended the claims to overcome the rejections under 35 U.S.C. §112.

Rejections Under 35 U.S.C. §102

Claims 1, 2, and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by LeSage (4,324,446). Claims 1, 2 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by Mech (5,511,873).

Applicant's invention comprises a carrying case adapted for storing, organizing, transporting, and displaying jewelry. In a preferred embodiment, the case includes a generally rectangular main body having a plurality of flat, rectangular panels attached to the peripheral side edges thereof. The rectangular panels are foldably positionable between a compact closed

configuration wherein the panels are disposed in adjacent overlapping relation within the main body to an open configuration wherein the rectangular sections are outwardly deployed. A significant aspect of the present invention relates to at least one of the panels being detachable. Upon detachment of the panel the user may close the panel in a compact configuration to permit the user to take selected jewelry items while traveling. The cited art fails to either teach or suggest such structure.

U.S. Patent No. 4,324,446, issued to LaSage, discloses a jewelry case having a front portion and a back portion defining at least one compartment therebetween. The front portion comprises a pair of closure members hingedly mounted to the back portion to provide easy access to the compartments. LaSage discloses hinges (42) to connect the closure members to the case. LaSage even suggests that the hinges may be "piano" type hinges. It is well known that the hinge structures disclosed by LaSage are completely different than Applicant's detachable panel. LaSage fails to either teach or suggest replacing the hinges with a detachable mount. Applicant has amended claim 1 to include a detachable panel by incorporating the limitation of cancelled claim 2. Accordingly, claim 1 and the claims that depend therefrom are believed to be distinguishable from the LaSage reference.

U.S. Patent No. 5,511,873, issued to Mech, discloses a jewelry cabinet comprising a generally rectangular housing with left and right doors pivotally connected to the housing and adapted to close the left compartment and right compartment respectively. Mech also discloses hinges (18) to connect the doors

to the housing in a manner similar to LaSage. Mech also fails to either teach or suggest replacing the hinges with a detachable mount. Accordingly, claim 1 and the claims that depend therefrom are believed to be distinguishable from Mech.

Rejections Under 35 U.S.C. §103(a)

Claims 1 – 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over LeSage or Mech in view of Roegner (5,890,587).

The Examiner cites Roegner for disclosing means for storing jewelry including closable pockets with a transparent portion. Roegner fails, however, to overcome the deficiencies of the LaSage and Mech references.

U.S. Patent No. 5,890,587, issued to Roegner, discloses a jewelry case, comprising a primary shell of pliable material formed of a substantially rectangular primary panel having an inner face and an outer face and foldable along a pair of lines transverse of the back panel forming a top panel section, an intermediate panel section and a bottom panel section, and wherein each panel section has a pocket assembly having at least one pocket with a transparent front panel.

Not only does the proposed combination of references fail to either teach or suggest a jewelry case with a detachable panel as disclosed and claimed by the present invention, Applicant is unable to find any teachings or suggestions that it would be desirable to combine the references as suggested by the Examiner. It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art

contain something to suggest the desirability of doing so. Ex parte Walker, 135 U.S.P.Q. 195 (1961). Furthermore, the Examiner must identify where the prior art provides a motivating suggestion for the combination. In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The Federal Circuit, in In re Jones, confirmed that “[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so . . .” (citing In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

As discussed above, the various references cited by the Examiner fail to teach or suggest the presently claimed invention, either alone or in combination. In addition, the cited references fail to teach or suggest the desirability of the combined teachings relied on by the Examiner. Accordingly, the proposed combinations are improper and fail to support rejection under 35 U.S.C. § 103. See, C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 USPTQ.2d 1225 (Fed. Cir. 1998) (There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination).

It is improper to use the inventor’s disclosure as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987). During prosecution, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987) (A holding that claims are invalid based

merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35). As the Federal Circuit has often stated, “virtually all [inventions] are combinations of old elements.” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

Accordingly, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the law requires the examiner to show a motivation to combine the references that create the case of obviousness. In Re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, is not evidence.

The Federal Circuit has identified three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. Id. In the present case the Examiner relies upon none of the three possible sources for motivation. Instead, after each citation of a particular feature in the cited art, the Examiner summarily concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of X by combining Y.” The Examiner has not, however, explained what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. When the Examiner does not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no

knowledge of the present invention to make the combination, it is presumed that the Examiner selected the references with the assistance of hindsight. Id. at page 1358.

While a suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997), rarely will the skill in the art operate to supply missing knowledge or prior art to reach an obviousness judgment. In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). If such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Id.

In Ex Parte Clapp, 227 USPQ 972, claims were rejected under 35 U.S.C. §103 when the Examiner combined a number of references. The Board in Clapp set out the requirement that the Examiner state a line of reasoning as to why the artisan, viewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. The Board in Clapp noted that the Examiner had done little more than “cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. 227 USPQ 972, 973. The Board held that “to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to

why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” 227 USPQ 972, 973. The Board could not find anything in the references to expressly or impliedly teach or suggest the modifications urged by the Examiner, nor could the Board find a line of reasoning advanced by the Examiner as to why the artisan would have concluded that the modifications urged by the Examiner were obvious. The Board held that, on the record before it, “the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.”

Applicants also rely on the decision of the Court of Appeals for the Federal Circuit in Carella v. Starlight Archery, 231 USPQ 644. One of the issues in Carella was the obviousness of the invention over the prior art. The CAFC noted that the Court below had acknowledged that use of vertical height for range finding, use of multiple elements on a sight and use of circular apertures were each known in the art, but concluded that the prior art lacked any teaching or suggestion to combine the separate features in a manner permitting use of circular apertures for simultaneous range finding. Obvious cannot be established by combining the teachings of the prior art to produced the claimed invention absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Both Carellly and Clapp stand for the proposition that the art, not the Examiner, must teach the suggested combination. Further, if the references do

not expressly or impliedly suggest the claimed combination then the burden falls on the Examiner to advance a line of reasoning which supports the position advanced by the Examiner.

In Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1498, 1 USPQ.2d 1337, 1343 (Fed. Cir. 1986), the court stated: "the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would suggest the desirability, and thus the obviousness, of making the combination." The record does not reveal any such suggestion or teaching that would lead to the Applicants' claimed invention.

In view of the amendments and arguments presented herein it is believed that that the claims are patentably distinguishable over the prior art. Accordingly, Applicants respectfully requests a favorable action on this case.

Should the Examiner have any questions, comments, or concerns, the undersigned would appreciate a telephone conference in order to expedite this case.

Respectfully submitted,

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Date: 4/21/05

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